

Attorney Docket: 112.P14114C

IN THE FIGURES

Please enter the replacement sheet for amended Figure 1, submitted herewith.

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CENTRAL FAX CENTER**FEB 26 2007****REMARKS****Status of Claims**

Claims 1, 6-9, and 14-26 are pending in the above-referenced patent application. In this response, claims 1, 9, and 17-20 have been amended, claims 25-26 have been added and no claims have cancelled. It is noted that claims 1, 9, and 17-20 were amended to more clearly delineate intended subject matter. It is respectfully submitted that adequate support for the amendments made to claims 1, 9, and 17-20 as well as new claims 25-26 may be found at least in the specification, figures, and claims as filed. Furthermore, the amendments to the claims and the new claims introduce no new matter. It is respectfully requested that the Examiner enter the amendments to claims 1, 9, and 17-20, enter new claims 25-26, and allow claims 1, 6-9, and 14-26 to proceed to allowance.

Amendments to the Figures

Assignee has submitted a replacement sheet for amended Figure 1. Figure 1 has been amended to correct inadvertent typographical errors. For example, item 30 has been amended to read "Scanner Driver", and item 50 has been amended to read "User Interface". It is respectfully submitted that adequate support for these amendments may be found in the specification as filed, and these amendments introduce no new matter. Accordingly, it is respectfully requested that the Examiner enter this replacement sheet for amended Figure 1.

Claim Rejections – 35 U.S.C §101

In the Final Office Action, dated December 26, 2006, the Examiner rejected claims 17-24 under 35 U.S.C. §101, for being directed to non-statutory subject matter. This rejection is respectfully traversed.

It is respectfully submitted that claims 17-24 are directed to subject matter that falls within the standards set forth in 35 U.S.C. §101. For example, as stated in *In re Beauregard*, 53 F.3d 1583, 35 USPQ2d 1383 (Fed. Cir. 1995), "The Commissioner now states that computer programs embodied in a tangible medium, such as floppy diskettes, are patentable subject matter under 35 U.S.C. §101 and

must be examined under 35 U.S.C. §§ 102 and 103." It is respectfully submitted that this standard applies here. Claims 17-24 are directed toward a computer-readable storage medium, which is a tangible medium per the standards set forth in *In re Beauregard*. Furthermore, as stated in MPEP § 2106.01:

When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. ... [A] claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

Accordingly, Assignee respectfully submits that claims 17-24 are directed to subject matter that falls within the standards set forth in 35 U.S.C. §101. It is, therefore, respectfully requested that the Examiner withdraw the rejection of these claims, and allow all pending claims to proceed to allowance.

Claim Rejections – 35 U.S.C §102(e)

The Examiner has rejected claims 1, 6-9 and 14-16 under 35 U.S.C. §102(e) as being anticipated by Lo (US Pat. No. 6,256,662). This rejection is respectfully traversed. Assignee respectfully submits that Lo does not show or describe each and every element of the rejected claims, as required by 35 U.S.C. §102(e), and, therefore, contrary to the Examiner's assertion, the claims are not anticipated by Lo under 35 U.S.C. §102(e).

Although Lo describes emulating a direct connection between a client and scanner connected via a server so that a client may control the scanner directly, Lo does not show or describe "performing a primitive scan operation on a document based on a set of default image processing settings to obtain a primitive scanned image; performing a set of image processing routines on the primitive scanned image to obtain image qualities of the document; specifying a set of image processing settings for the document based at least in part on the obtained image qualities; and performing a second scan on the document based at least in part on the specified image processing settings". In Lo, scanning

parameters may be set for an original scan via the emulated direct connection, and may be arbitrarily set by the client. However, Lo does not show or describe specifying a set of image processing settings "based at least in part on the obtained image qualities". For example, quoting from col 9:15 – 9:22 of Lo:

[T]he scanner image table 160 includes a scanning parameters field 170 which is an array of scanning parameters which are set for the client. The scanning parameters field 170 allows the user to set the scanning parameter from the client computer and when the scanning is performed at the server computer, the scanning is performed in accordance with the scanning parameters set in the table 170.

Furthermore, quoting from col 15:46 – 15:47 of Lo:

FIG. 10 illustrates an image of a computer screen which allows the user to set the parameters of the scanner. For example, the resolution, brightness, and contrast are set using slidable graphic control buttons. There is no slidable mark illustrated for the threshold so for this particular scanner, it may not be possible to adjust the threshold. Exemplary modes which can be used include line art (e.g., black and white), halftone, 16 level gray scale, and 256 level gray scale. The halftone list box is only utilized when the halftone mode has been selected. In the error diffusion halftone mode, a diffuse random pattern is produced.

Furthermore, FIG. 10 of Lo is reproduced below:

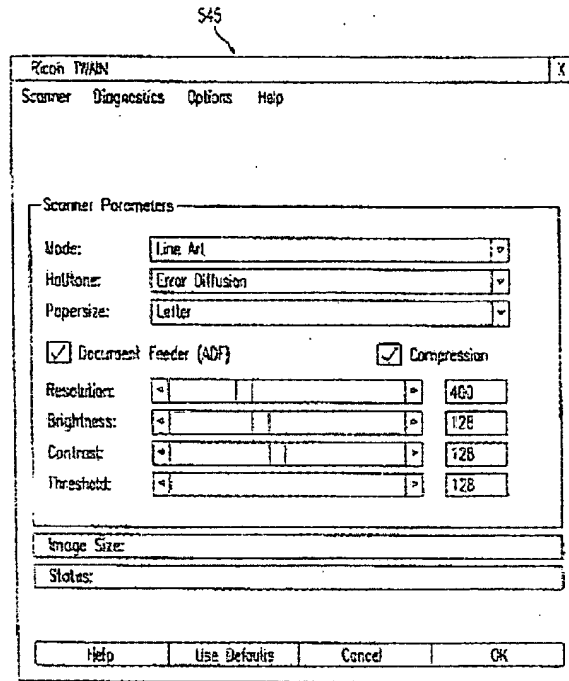


FIG. 10

Accordingly, it is respectfully submitted that Lo fails to show or describe all the elements of claim 1. For example, as shown above, Lo does not show or describe specifying a set of image processing settings "based at least in part on the obtained image qualities", but, rather, merely allows a client to arbitrarily set scanning parameters for an original scan. Therefore, because Lo fails to show or describe each and every element of the rejected claims, a sufficient showing of anticipation has not been established, and claims 1, 6-9, and 14-16 are in condition for allowance. Additionally, claims 17-24 include limitations similar to those in one or more of claims 1, 6-9, and 14-16, and, therefore, are in a condition for allowance for at least the same reasons. Furthermore, new claims 25-26 include similar limitations of those present in one or more of claims 1, 6-9, and 14-16, and are allowable on at least the same basis.

According to the Examiner, in the Final Office Action, page 6, "Applicant alleges that Lo does not teach the execution of the scanner driver to perform a set of image processing routines on the

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primitive scanned image to obtain the image qualities of the document. Applicant offers no support for this contention." It is respectfully noted that the Assignee has provided support for this contention, by specifically pointed out at least one deficiency of the cited art. Furthermore, the Examiner is respectfully reminded of the initial burden of the Examiner to first establish a *prima facie* case of anticipation. As mentioned above, a *prima facie* case of anticipation may only be established by cited a prior art reference that shows and describes each and every element of the rejected claims. Furthermore, for at least the reasons set forth above, a *prima facie* case of anticipation under 35 U.S.C. 102(e) has not been established, and the Examiner has the burden to demonstrate where in the cited art the noted deficiencies may be found.

Assignee respectfully submits that because a sufficient showing of anticipation has not been established, all pending claims are in a condition for allowance. It is noted that many other bases for traversing the rejections could be provided, but Assignee believes that the grounds presented above are sufficient. It is, therefore, respectfully requested that the Examiner withdraw the rejection of these claims, and allow all pending claims to proceed to allowance.

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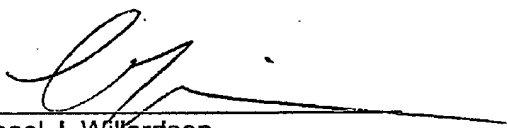
FEB 26 2007

CONCLUSION

In view of the foregoing, it is respectfully submitted that all of the claims pending in this patent application, as amended, are in condition for allowance. If the Examiner has any questions, he is invited to contact the undersigned at (503) 439-6500. Reconsideration of this patent application and early allowance of all the claims is respectfully requested.

Please charge any shortages and credit any overcharges of any fees required for this submission to Deposit Account number 50-3703.

Respectfully submitted,

Dated: February 26, 2007
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